

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

MACROSOLVE, INC.,	§	CIVIL ACTION NO. 6:11-cv-287
	§	
v.	§	CONSOLIDATED LEAD CASE
	§	
ANTENNA SOFTWARE, INC. et al.	§	

**MACROSOLVE INC.’S UNOPPOSED MOTION FOR DISMISSAL WITH
PREJUDICE OF ITS ACTION AGAINST NEWEGG INC. AND DISMISSAL
WITHOUT PREJUDICE OF NEWEGG’S COUNTERCLAIMS FOR
DECLARATORY JUDGMENT FOR LACK OF SUBJECT MATTER JURISDICTION**

Plaintiff MacroSolve, Inc. (“MacroSolve”) hereby moves pursuant to Rule 41(a)(2) for voluntary dismissal with prejudice of its Complaint for patent infringement against defendant Newegg, Inc. (“Newegg”), and pursuant to Rule 12(b)(1) of the Federal Rules of Civil Procedure for an order dismissing without prejudice Newegg’s counterclaims for declaratory judgment of invalidity and non-infringement for lack of subject matter jurisdiction. Newegg does not oppose this motion.

In addition, MacroSolve unconditionally agrees not to sue Newegg for infringement as to any claim of the patent-in-suit based upon Newegg’s manufacture, importation, use, sale and/or offer for sale of the products currently or in the past manufactured and sold by Newegg, or systems currently or in the past used or offered by Newegg, including all mobile apps operated and mobile app functionalities offered, currently or in the past, by Newegg. Here, statements made by counsel for MacroSolve are binding statements that preclude MacroSolve from asserting infringement of the patent-in-suit against Newegg’s past and current products and systems. MacroSolve further agrees not to sell, transfer, or assign, or to license with the right to

sue, the patent-in-suit to any third party under common ownership or control with MacroSolve without binding such a third party to the covenants made by MacroSolve herein.

In light of MacroSolve's covenant not to sue with respect to the patent-in-suit as to current and past products and systems, Newegg has no reasonable apprehension that it will face liability for infringement as to these claims. The Court therefore does not have subject matter jurisdiction over these claims as Newegg cannot satisfy the first prong of the justiciability test. *See Super Sack Mfg. Corp. v. Chase Packaging Corp.*, 57 F.3d 1054, 1059 (Fed. Cir. 1995). Without an actual case or controversy, the Court is divested of jurisdiction. *Id.*

In light of MacroSolve's covenant not to sue Newegg and its voluntary dismissal of its claims for relief, MacroSolve's unopposed motion to dismiss the action against Newegg with prejudice and Newegg's counterclaims without prejudice for lack of subject matter jurisdiction should be granted.

Respectfully Submitted,

Dated: March 12, 2014

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CERTIFICATE OF SERVICE

I hereby certify that on the 12th day of March, 2014, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system, which will send notification of such filing to all counsel of record.

/s/ Califf T. Cooper
Califf T. Cooper

CERTIFICATE OF CONFERENCE

I hereby certify that I have complied with Local Rule CV-7. Specifically, I have conferred with counsel for defendants who has confirmed that the requested relief is unopposed.

/s/ Califf T. Cooper
Califf T. Cooper